The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 43

Filed by: Carol A. Spiegel
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Carol A. Spiegel)

QUIG WANG, MITCHELL H. FINER
and XIAO-CHI JIA

Junior Party,
Application 08/333,680

v.

JEAN-LUC IMLER, MAJID MEHTALI
and ANDREA PAVIRANI

Senior Party
Application 09/218,143
Application 09/739,007

Patent Interference No. 105,136

ORDER REDECLARING INTERFERENCE
(37 CFR § 1.611)

I. Background history

A. In lieu of granting Imler preliminary motions 1-5 in Interference 104,821, redeclaring the interference and proceeding to its priority phase on Count 1 and a new Count 2, this interference (directed to Count 2) was declared for procedural and administrative reasons.

Interference 105,136 already has a history. It was spawned as result of the decision on remaining motions (Paper 116, pp. 22-30) in parent interference 104,821. In relevant part, the parent decision reads:

> ...[I]n our opinion, a count[1] directed to recombinant adenoviruses/vectors having deletions and/or mutations in both the E1 and E4 regions is appropriate. However, it is not appropriate to add such a count in this interference for at least the following reasons.
>
> * * * * * *
>
> Dismissing Imler preliminary motion 1, subject to the APJ taking further appropriate action, i.e., declaring a new interference between the parties wherein the sole count was substantially identical to proposed Count 2 in accordance with Imler preliminary motion 1, would provide a final decision as to this interference and avoid having Imler be both senior and junior party in the same interference. Moreover, since both parties have had the opportunity for motions, oppositions, replies and testimony as to Imler preliminary motions 1 through 5, there appears to be no reason, absent a showing of good cause, why the proposed interference should not proceed directly to the priority phase. The parties already have copies of the involved files and have had the opportunity to review and act upon them.
>
> Therefore, for the reasons given above, Imler preliminary motion 1 is **dismissed, subject to the APJ taking further appropriate action**. [Interference 104,821, Paper 116, pp. 28-30, original emphasis.]

B. A conference call was held on August 19, 2003 at approximately 2:00 p.m. to discuss why interference 105,136 should not proceed directly to its priority phase.[2]

The parties were asked to discuss why this interference should not proceed directly to its priority phase and, if not, what preliminary matters should be attended to and why (Paper 1, p. 2; Paper 3, p. 1). According to senior party Imler, this interference should proceed directly to its priority phase (Paper 12, p. 2). According to junior party

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[1] Proposed Count 2 was the disjunctive of any of Imler claims 66 or 67 or any of Wang claims 47 or 38 or 46, wherein the two gene regions are E1 and E4, or 47. This is identical to Count 1, the sole count, of this interference.

[2] The telephone conference involved (1) Carol A. Spiegel, Administrative Patent Judge (APJ), (2) Steven B. Kelber, Esq., counsel for Wang and (3) Todd R. Walters, Esq. and Susan M. Dadio, Esq., counsel for Imler.

Wang, a preliminary motions period, albeit an expedited one, could not be avoided (Paper 13, p. 2). Specifically, Wang argues that

> [i]n contrast to the position expressed by Imler, Wang notes that Imler's claims are unpatentable over art the Board specifically found was not before it in Interference 104,821. At a minimum, it would be inappropriate to proceed to priority on subject matter unpatentable to Imler. Further, given the Decision of the Board in Interference 104,821, Wang does not believe Imler is entitled to benefit accorded it, and Wang intends to advance additional claims corresponding to the Count. [Paper 13, p. 2.]

1. Wang has already had a full and fair opportunity to question the patentability of the involved Imler claims 66 and 67.

In its opposition to Imler preliminary motion 2 in parent interference 104,821, Wang expressly attacked the patentability of the Imler claims involved in this interference. Wang argued in part that Imler claims 66 and 67 were unpatentable over the prior art. However, as stated in the parent decision,

> [i]t is Wang's burden to see that each prior art reference that it relies upon is in evidence before the Board, particularly after Imler brought the apparent problem of Bridge 1990 [the "missing" prior art reference] to Wang's attention in its reply. There is no record of Wang requesting a conference call or taking any other action to correct this problem. ... [Interference 104,821, Paper 116, p. 25.]

Thus, Wang's failure to meet its burden of persuasion in the first instance regarding the alleged unpatentability of Imler claims 66 and 67 over prior art is not good cause to have a preliminary motion phase in this interference. The issue has already been addressed.

2. Wang has already challenged the entitlement of Imler claims 66 and 67 to their accorded priority benefit.

Wang already challenged the priority benefit accorded Imler when it opposed Imler preliminary motions 3 through 5 in the parent interference and failed to meet its burden of persuasion (Interference 104,821, Paper 116, pp. 30-32). An issue which has already been addressed is not good cause to have a preliminary motion phase in this interference.

3. Advancing new Wang claims does not affect the count.

Finally, an intention to advance additional claims corresponding to the Count does not affect the Count. It does not materially advance the purpose of an interference, i.e., to determine priority of invention under 35 U.S.C. § 102(g) of the subject matter of the Count.

C. An APJ has discretion to add an application to an interference

> During the pendency of an interference, if the administrative patent judge becomes aware of an application or a patent not involved in the interference which claims the same patentable invention as a count in the interference, the administrative patent judge may add the application or patent to the interference on such terms as may be fair to all parties. 37 CFR § 1.642.

1. Imler application 09/739,007, a divisional of Imler application 09/218,143, claims the same patentable invention as the count.

Imler application 09/739,007 (Imler '007), a divisional of the originally involved Imler application 09/218,143 (Imler '143), has come to the attention of the APJ. Claims 73-92 of Imler '007 have been indicated to be allowable. Claims 73-77, 80-88, 91 and 92 are directed to replication defective adenoviruses/vectors having deletions in all or a part of the E1 and E4 regions and all of the E3 region. The E3 region is not essential to the replication of the virus/vector and integration of exogenous nucleotide sequences in place of the E3 region is known in the prior art. Thus, additional deletion of the E3 region in replication-deficient recombinant adenoviruses/vectors having deletions and/or mutations in both the E1 and E4 regions would have been both obvious (to provide additional integration of exogenous nucleotide sequences) and within ordinary skill in the art.

2. Addition of Imler '007 would not change the count.

Addition of Imler '007 and designation of its claims 73-77, 80-88, 91 and 92 as corresponding to the present Count would not affect the Count and would avoid an additional interference.

II. Conclusion

For the above reasons and to secure the just, speed and inexpensive

determination of the interference,

1. Imler application 09/739,007 is being added to the interference.

2. Claims 73-77, 80-88, 91 and 92 of Imler application 09/739,007 are being designated as corresponding to the Count.

3. Wang and Imler have **one (1) week** from the filing of this order to submit any proposed preliminary motions necessitated by the interest of justice. The feeling of the APJ at this time, in view of the history of this interference, is that the only necessary preliminary motion before entering the priority phase might be a motion by Imler to designate claims 73-77, 80-88, 91 and 92 of Imler application 09/739,007 as not corresponding to Count 1. The movant should show good cause as to why any motion that does not affect Count 1 is necessary. After all, determination of priority does not require a determination of patentability.

4. In the event that Imler should prevail on priority, the APJ would consider any evidence submitted by Wang, e.g., a "missing" prior art reference, bearing on the patentability of any involved Imler claim(s), provided that Wang submitted such evidence by the first time period set in this interference, whether a preliminary motion or a priority time period 1. If appropriate, the APJ may either enter an order under 37 CFR § 1.641 notifying the parties of any reason why a claim designated as corresponding to the count may be unpatentable or enter a recommendation under 37 CFR § 1.659 to the examiner to take further appropriate action.

III. Declaration of interference

An interference is declared (35 U.S.C. §135(a)) between the above-identified parties. Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

IV. Judge designated to handle the interference

Administrative Patent Judge Carol A. Spiegel has been designated to handle the interference. 37 CFR § 1.601(a).

V. Standing order

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

VI. Conference call to set dates

A telephone call to discuss setting dates for taking action in the interference is scheduled for **10:00 a.m. on October 7, 2003** (the call will be initiated from the PTO).

A copy of a "sample" order setting times for taking action during the priority phase of the interference accompanies this ORDER REDECLARING INTERFERENCE.

VII. The parties involved in this interference are:

Junior Party

Named inventors:	QING WANG, MITCHELL H. FINER and XIAO-CHI JIA
Application:	08/333,680, filed November 3, 1994
Title:	Novel Adenoviral Vectors, Packaging Cell Lines, Recombinant Adenoviruses and Methods
Assignee:	CELL GENESYS, INC.
Accorded Benefit:	None
Attorneys:	See last page
Address:	See last page

Senior Party

Named Inventors:	JEAN-LUC IMLER, MAJID MEHTALI and ANDREA PAVIRANI
Application:	09/218,143 (Imler '143) filed December 22, 1998
Title:	Defective Adenoviruses and Corresponding Complementation Lines

Assignee:	TRANSGENE S.A.
Accorded Benefit:	of application 08/379,452, filed January 26, 1995 of PCT application PCT/FR94/00624, filed May 27, 1994 of FR application 93 06482, filed May 28, 1993

Named Inventors:	JEAN-LUC IMLER, MAJID MEHTALI and ANDREA PAVIRANI
Application:	09/739,007 (Imler '007), filed December 19, 2000
Title:	Defective Adenoviruses and Corresponding Complementation Lines
Assignee:	TRANSGENE S.A.
Accorded Benefit:	of application 09/218,143 (Imler '143) filed December 22, 1998 of application 08/379,452, filed January 26, 1995 of PCT application PCT/FR94/00624, filed May 27, 1994 of FR application 93 06482, filed May 28, 1993
Attorneys:	See last page
Address:	See last page

VIII. Count and claims of the parties

Count 1

The recombinant adenoviral vector of claim 46 of Wang 08/333,680, wherein the two gene regions are E1 and E4

or

The recombinant adenoviral vector of claim 38 or 47 of Wang 08/333,680

or

The recombinant adenovirus of claim 66 of Imler 09/218,143

or

The recombinant adenoviral vector of claim 67 of Imler 09/218,143.

The claims of the parties are:

Wang	37-48, 52, 54, 56-57
Imler '143	56-57, 59, 61-67
Imler '007	73-92

The claims of the parties which correspond to Count 1 are:

Wang	37-38, 46-47, 52, 54, 56
Imler '143	66-67
Imler '007	73-77, 80-88, 91-92

The claims of the parties which do not correspond to Count 1, and therefore are not involved in the interference, are:

Wang	39-45, 48, 57
Imler '143	56-57, 59, 61-65[3]
Imler '007	78-79, 89-90

[3] Imler claims 56-57, 59 and 61-65 have been found unpatentable in related interference 104,821 (Paper 116).

IX. Heading to be used on papers

The following heading shall be used on papers filed in the interference. See ¶ 3.5 of the STANDING ORDER.

Paper ___[4]

Filed on behalf of [name of party]
By: Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Carol A. Spiegel)

QING WANG, MITCHELL H. FINER
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Junior Party,
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v.

JEAN-LUC IMLER, MAJID MEHTALI
and ANDREA PAVIRANI

Senior Party
Application 09/218,143
Application 09/739,007

Patent Interference No. 105,136

TITLE OF PAPER

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[4] Leave a blank line because the board assigns the paper number.

X. Order

It is

ORDERED that within **one (1) week** of the date of this ORDER, each party will file a justified list of any proposed preliminary motions.

FURTHER ORDERED that, to the extent applicable, the procedures set forth in the attached STANDING ORDER are in effect for the remainder of the interference.

FURTHER ORDERED that the caption of papers filed in the remainder of the interference shall be the caption as set forth in the appendix to this ORDER.

FURTHER ORDERED that within **14 (fourteen) days** of the date of this ORDER, each party shall either: (1) refile the preliminary statement it has already filed in parent interference 104,821 for the subject matter of Count 1 or (2) file a new preliminary statement for the subject matter of Count 1.

FURTHER ORDERED that a conference call is scheduled for **two weeks hence at 10:00 am** to set times for taking action in the interference. The call will be initiated by the PTO.

XI. Signature of administrative patent judge

Carol A. Spiegel

CAROL A. SPIEGEL
Administrative Patent Judge

Date: September 23, 2003
Arlington, VA

Enc: Copy of STANDING ORDER

Copy of order used for setting times for taking action in the testimony and briefing phases of the interference

Copy of claims of application 09/739,007

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